

REMARKS

Applicant requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1-31 are pending in the present application. Claims 1, 7, 12, 18, 26, and 32 are the independent claims.

Claims 2, 8, 19, and 27 have been amended. No new matter is believed to have been added.

The Office Action objected to the title as being not descriptive. In response, Applicant has amended the title in a manner believed to even more accurately describe the claimed subject matter.

Favorable consideration is respectfully requested.

The Office Action objected to the drawings for, as best understood by Applicant, not showing all the features of claims 6, 11, 16, 17, 22, and 31. However, the Office Action fails to identify which feature(s) is/are not shown by the drawings. Further, it is respectfully submitted that substantial portions of text appear to have been omitted, such omissions rendering this objection impossible to deduce with the specificity required to ensure a complete and accurate response thereto.

Accordingly, clarification of the specific ground(s) for this objection are respectfully requested.

Claims 1-31 stand rejected under 35 U.S.C. § 112, first paragraph, as non-enabled. Specifically, the Office Action contends that "the independent claims recite the limitation that dummy data is recorded Not [sic] at the interrupted position, but offset therefrom – backward for example." (Office Action, page 2). This rejection is respectfully traversed.

Initially, Applicant respectfully directs attention to the various recited features of independent claims 1, 7, 12, 18, 26, and 32, none of which recite the specified feature. Rather, the Office Action's allegation is a characterization of the recitations of these claims.

Turning to the merits of this rejection, attention is respectfully directed to paragraphs [0028], [0029], [0052], and [0053] of Applicant's disclosure, where Applicant explains that, after a shock error, an optical pickup is moved a predetermined distance back from an estimated position to generate new position information and record dummy data from the new position for a predetermined period of time. Further, the predetermined period of time is relative to an

absolute time corresponding to the estimated position in that the predetermined period of time is subtracted from the absolute time to obtain a new absolute time and allow the optical pickup to be located in a position corresponding to the new absolute time. Then, dummy data is overwritten from the position corresponding to the absolute time for a predetermined period of time. Applicant respectfully submits that such disclosure is sufficiently enabling.

Accordingly, favorable reconsideration and withdrawal of the rejection under the first paragraph of 35 U.S.C. § 112 are respectfully requested.

The Office Action rejected independent claim 32 under the first paragraph of 35 U.S.C. § 112, as analogous to a single means claim. This rejection is respectfully traversed.

Initially, Applicant notes that the Office Action relies on In re Hyatt as sole support for the allegation that a method claim reciting a single step is analogous to a single means claim. (Office Action, page 3). However, a review of In re Hyatt reveals that this case merely supports the proposition that a single means claim does not satisfy the enablement requirement of the first paragraph of 35 U.S.C. § 112. As such, the allegation that a single step method claim also fails to satisfy the first paragraph of 35 U.S.C. § 112 is wholly unsupported. Also, it is respectfully submitted that the attempted analogy between method and means-plus-function claims fails as a matter of law since 35 U.S.C. § 112 defines them as legally discrete and separate categories of claims. Further, Applicant respectfully submits that claim 32 expressly recites an operation (“recording dummy data”) and, as such, does not merely recite a function defined “by all possible steps”. For these reasons, this rejection is traversed.

Accordingly, favorable reconsideration and withdrawal of the rejection under the first paragraph of 35 U.S.C. § 112 are respectfully requested.

Claims 2, 8, 19, and 27 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. In response, these claims have been amended in a manner believed to even more fully satisfy the requirements of the second paragraph of 35 U.S.C. § 112. Specifically, the recitation “non-standard value” has been further defined based on the description at paragraph [0040] of the Specification.

Accordingly, favorable reconsideration and withdrawal of the rejection under the second paragraph of 35 U.S.C. § 112 are respectfully requested.

Claims 1, 7, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,099,246 (Hayashi et al.) further considered with JP 10-143980 (JP ‘980).

Claims 3-5, 9, 10, and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable

over Hayashi et al. and JP '980, and further in view of U.S. Patent No. 6,671,249 (Horie). Claims 6, 11, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi et al. and JP '980, and further in view of U.S. Patent No. 6,762,980 (Kadlec et al.). Claims 12, 17, 18, 24, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi et al. and JP '980, and further considered with U.S. Patent No. 6,628,602 (Ohno et al.). Claims 13-15, 20, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi et al., JP '980, and Ohno et al., and further in view of Horie. Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi et al., JP '980, and Ohno et al., and further in view of Kadlec et al.. Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi et al., JP '980, and Ohno et al., and further in view of Kadlec et al.. Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayashi et al., JP '980, and Ohno et al., and further in view of U.S. Patent No. 6,163,515 (Yamamoto et al.). All rejections are respectfully traversed.

It is respectfully submitted that the Office has failed to make out a prima facie case of obviousness for at least the reasons set forth below. As a result, the rejection is traversed.

As the Office Action concedes, Hayasahi et al. does not disclose writing dummy data. (Office Action, page 5). Nonetheless, the Office Action contends that JP '980 provides the necessary disclosure of this feature and that one of ordinary skill in the art would have been motivated to modify Hayashi et al. in view of JP '980. (Office Action, page 3). This latter rejection is traversed.

A prima facie case of obviousness requires some suggestion or motivation, either in the cited art or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. (Manual of Patent Examining Procedure (MPEP), § 2143). Thus, obviousness can only be established by combining or modifying the teachings of the cited art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. MPEP § 2143.01 (I)(emphasis added). It is for this reason that the mere fact that art can be combined or modified does not render the resultant combination obvious unless the cited art also suggests the desirability of the combination. MPEP § 22143 (III)(emphasis added).

The MPEP makes clear that the Office bears the initial burden of factually supporting any prima facie conclusion of obviousness. (MPEP 2142). And, when the motivation to combine the teachings of the art is not immediately apparent, it is the Office's burden to explain why the combination of the teachings is proper. (MPEP § 2142). This burden requires a "convincing" line of reasoning as to why one of ordinary skill would have made the suggested modification, when,

as is the case at present, the references do not expressly or impliedly suggest the claimed invention. (See MPEP § 2142) (to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references).

Regarding the rejection of independent claims 1, 7, and 26 under 35 U.S.C. § 103, the primary citation to Hayashi et al. relates to a method and apparatus for recording data on an optical disc without restarting writing of data after data recording interruption. This patent discusses data recording equipment including a counter and a controller. The counter counts execution of recording data and generates a count value indicating the amount of data that is recorded. The control unit is connected to the counter and (1) holds the count value of the counter immediately before an interruption and (2) controls restart of the recording of data based on the held count value. To do this, the controller re-irradiates a position on the optical disc, on which data prior to the data recorded immediately before the interruption is recorded. (Hayashi et al., Col. 10, lines 45- Col. 11, line 30). In this way, Hayashi et al. “accurately restarts” data writing after an interruption (Hayashi et al., Abstract).

Absent from Hayashi et al. is any discussion or suggestion of any need to record dummy data. This absence is not surprising since Hayashi et al. seeks to avoid the need for dummy data by “accurately” restarting data writing after an interruption. Indeed, Hayashi et al. expressly teaches that the data to be recorded on the disc is recorded in a continuous manner. (Hayashi et al., Col. 11, lines 5-12). Thus, the primary citation to Hayashi et al. actually seeks to avoid the use of dummy data.

Consequently, it is not reasonable to conclude (1) that the motivation to make the suggested combination/modification is apparent or (2) that there is some teaching, suggestion, or motivation in either Hayashi et al. or JP '980 to make the suggested combination/modification. Indeed, in this regard, Applicant notes the absence of any identification of specific support by the Office in either Hayashi et al. or JP '980 for the suggested combination/modification.

Therefore, to establish a prima facie case of obviousness, the Office must provide a convincing line of reasoning as to why the dummy data recording of JP '980 should be added to the method and apparatus that avoids using dummy data described in Hayashi et al. However, the Office merely reasons that one of ordinary skill would have made the suggested modification because:

[the modification would] record/place dummy data in to [sic] areas affected by a shock, so as to ensure proper signal recording.

(Office Action, page 5). It is respectfully submitted that Office has failed to explain why the skilled artisan would be motivated to modify Hayashi et al., which seeks to avoid the need dummy data, in view of JP '980, which discloses recording dummy data. Instead, the Office articulates a speculative result. Stated another way, the aforementioned line of reasoning does not even address why the skilled artisan looking at Hayashi et al. would modify it to record dummy data. Thus, it is respectfully submitted that the stated rationale is not "convincing" as required by the MPEP and is thus insufficient to support a prima facie case of obviousness.

Regarding the rejections of independent claims 12 and 18, Ohno et al. relates to an optical information recording medium and is cited for its alleged teachings of "having PMA in this environment" and "recording of dummy data positions." (Office Action, page 6). While not conceding the propriety of the asserted combination of Ohno et al. to either of Hayashi et al. or JP '980, Applicant respectfully submits that Ohno et al. does not add anything to the respective disclosures of Hayashi et al. or of JP '980 that would obviate each feature of independent claims 1, 7, 12, 18, and 26. And, for the reasons set forth above, Applicant again points out that a combination of Hayashi et al. with JP '980 is improper.

Regarding the rejections of the dependent claims under 35 U.S.C. § 103, Horie relates to an optical recording medium, data recording method for rewritable-type phase change type optical disc, data erase method for rewritable compact disc, data erase method for rewritable phase change type recording medium, read only data erase method, and recording/readout apparatus, Kadlec et al. et al. relates to a digital tracking servo system with a multi-track seeking and accelerated servo function for regaining a closed tracking loop, and Yamamoto et al. relates to an optical disk writing control device. Applicant respectfully submits that none of these patents add anything to the disclosures of Ohno et al. and either Hayashi et al. or JP'980 that would obviate each feature of independent claims 1, 7, 12, 18, and 26.

Accordingly, favorable reconsideration and withdrawal of the rejections of independent claims 1, 7, 12, 18, and 26 are respectfully requested.

In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicant believes that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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